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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,819	10/20/2003	Yasushi Shikata	03560.003386.	2635
5514 7590 09/15/2009 FITZPATRICK CELLA HARPER & SCINTO 1290 Avenue of the Americas NEW YORK, NY 10104-3800				
EXAMINER				
THOMAS, JASON M				
ART UNIT		PAPER NUMBER		
2423				
MAIL DATE		DELIVERY MODE		
09/15/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/687,819

Applicant(s)

SHIKATA ET AL.

Examiner

Jason Thomas

Art Unit

2423

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/02)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 11, 2009 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto, U.S. Pat. No. 7,302,696 B1 (hereinafter Yamamoto), in view of Gregory, U.S. Pat. No. 5909,673 (hereinafter Gregory), Bentolila et al., U.S. Pub. No. 2003/0101451 A1 (hereinafter Bentolila), Nishi et al., WO 01/65852 A1 (citations rely on U.S. 2003/0023968 A1 - hereinafter Nishi), Holman, U.S. Pat. No. 5,285,278 (hereinafter Holman) and Bradley et al., U.S. Pub. No. 2008/0098291 A1 (hereinafter Bradley).

Regarding claims 1, 12 and 13-18: Yamamoto teaches a signal processing apparatus and method comprising: a receiver for receiving data comprising print contents (see [abstract], [col. 2, ll. 24-38], [col. 3, ll. 15-26] for a receiver which receives data comprising printable contents) transmitted from a sender so as to be simultaneously receivable by a plurality of receivers (see [col. 2, ll. 13-24], [col. 7, ll. 1-12] where coupon data is broadcasted on a channel accessible by a plurality of users); and a processor for outputting, to a printer, print data in accordance with both of the data received by the receiver and user information of a user of the signal processing apparatus (see [col. 8, ll. 11-27] where a set top box which is connected to a set top box printer inherently has a processor for outputting to a printer; see also [fig. 17], [cols. 10-11, ll. 59-8] for print data that is in accordance with coupon data and user information).

Yamamoto also teaches wherein the data received by the receiver comprises a plurality of print contents (first data); wherein the processor automatically selects one of the plurality of print contents in accordance with the user information, and obtains the print data from the selected print content (see [cols. 10-11, ll. 59-28] where the print contents received from a remote location can all be stored on the local set top box and selected in the same manner from that local location using user-related data to correlate which print content best matches the user); and wherein the user information comprises a location where the user is viewing a program, such that the processor selects one of the plurality of print contents in accordance with the location; the user information comprises information identifying

the user, and the processor selects one of the plurality of print contents in accordance with the information identifying the user; and the user information comprises information identifying a television set used by the user, such that the processor selects one of the plurality of print contents in accordance with the information identifying the television set (see [col. 4, ll. 3-20], [cols. 10-11, ll. 59-28] correlation using user-related data which is used for correlating containing a location of where the user is viewing, identification of the user, and information identifying a television set; see also [col. 2, ll. 13-24] for coupon selection which is correlated with a television program the user is watching at a particular time at which it is broadcast).

Yamamoto however does not explicitly teach the concept of sub-print contents; does not adequately teach the act of correlating coupons with user data or wherein the print content is constructed in a mark-up language.

Gregory teaches a means of printing site specific coupons using print contents and sub-print contents (second data) where the sub-print contents are added prior to printing upon determining how to best customize the coupon to modify it for a particular use (see [col. 3, ll. 57-67], [col. 7, ll. 1-31] where information like the discount amount, expiration date, particular product, valid hours and dates are examples of some of the sub-print contents which can loaded into storage and later combined as needed to modify the print contents).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the print contents by using print content

templates which can be customized for a specific use by also providing sub-print contents which can be inserted prior to printing to fit a particular use, which reads on rewriting text data relating to the sub-print content, as taught by Gregory, in order to respond quickly to unique marketing conditions and tailor the coupons to target the needs of a particular type of customer, location or market.

Bentolila teaches a system for targeting data which collects viewing data to describe the preference or habits of a viewer which include recording a time when the user started watching a program (see [26], [27], [105]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the type of user related data which is collected, as taught in Yamamoto, by including data which tracks a time when a user started watching a program as taught by Bentolila in order to identify which advertiser or content providers the viewer may be interested in (see [105]).

While Gregory does not teach the methods of using a mark-up language to accomplish the modification of the general coupon templates with information specific to a particular customizable feature, Gregory does show that data relating to the sub-print content is rewritten (modified) according to specific missing information needed to complete the coupon (see [col. 7, ll. 1-31]).

Bradley however, teaches a similar system which uses generic templates, constructed using XML, to receive manually entered user information or can provide automatic customization by populating empty fields using well known database lookup functions, which is analogous Gregory's template modification and which

accomplishes the same end result; a user specific form ready for printing by the user (see [37], [45], [47]). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the means of customizing templates, by using a mark-up language as the means to customize the template, as taught by Bradley, because mark up languages, as demonstrated, are well suited to provide dynamic forms such as customer statements, invoices, order confirmations, or even insurance policies which are analogous in functional design to the site specific forms taught in Gregory.

Regarding claim 20: The combined teachings of the aforementioned prior art, teach a memory unit adapted to store the data-broadcast data, wherein the processing unit accesses the memory unit in response to a user's operation so as to output the print data for print content with setting information including at least one of information specifying the number of sheets to be printed and identification information of the print content (see Yamamoto [figs. 10, 11], [col. 8, ll. 11-27], [col. 8, ll. 28-39], [col. 8, ll. 50-61] where identification information, which specifies the coupon to be printed, is an inherent part of the printing process which allows the user to select a particular coupon, saved in a storage area "My Coupons", such that the user can send a specifically selected coupon among the other saved coupon to the printer for printing).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Thomas whose telephone number is (571) 270-5080. The examiner can normally be reached on Mon. - Thurs., 8:00 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Koenig can be reached on (571) 272-7296. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

J. Thomas

/Andrew Y Koenig/
Supervisory Patent Examiner, Art Unit 2423